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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

cab

Opposition No. 104,343
Opposition No. 104,344

Paul A. Holmquist and Colleen P. Holmquist, dba Synergy Physical Therapy

v.

Synergy Rehabilitation, Inc.

Before Quinn, Wendel and Bottorff, Administrative Trademark Judges.

By the Board:

Applicant has filed two applications to register the following marks:

SYNERGY. WORKING TOGETHER WORKS.[1]

and

[1] Application Serial No. 74/699,781, typed form, filed on May 4, 1995, and claiming use in commerce since February 1994.
[2] Application Serial No. 74/699,781, filed on May 4, 1995, and claiming use in commerce since February 1994; "REHABILITATION, INC." disclaimed.

each for "physical, occupational and speech therapy" in Class 42. As grounds for the opposition, opposers allege that applicant's marks so resemble opposers' previously used and registered mark SYNERGY PHYSICAL THERAPY[3] for "physical therapy services" in Class 42 and opposers' previously used mark SYNERGY, used in connection with opposers' "physical therapy and related or associated services," as to be likely to cause confusion, mistake or deception.

In its answers, applicant admits that "February 1994 is the first use date alleged in its application for the subject mark;" alleges that it began using "the tradename SYNERGY REHABILITATION SERVICES" during 1993; and otherwise denies the salient allegations of the notices of opposition.

This case now comes up on the parties' cross motions for summary judgment; applicant's alternate motion to divide its applications pursuant to Trademark Rule 2.86(a), to which opposers have responded; opposers' objection to the evidence submitted by applicant in its cross motion for summary judgment, to which applicant has responded; applicant's objections to opposers' addition to the record for summary judgment, to which opposers have responded; and opposers' request for leave to file a new paper in the nature of a petition decision by the Assistant

[3] Registration No. 1,915,713, registered on August 29, 1995, and claiming use in commerce since June 17, 1993 (date of first use set forth as January 22, 1991); "PHYSICAL THERAPY" disclaimed.

Commissioner for Trademarks and request for leave to file newly acquired evidence, to which applicant has not responded.

In support of their motion for summary judgment, opposers argue that there are no genuine issues of material fact, that likelihood of confusion exists, and that they are entitled to judgment as a matter of law. Opposers contend that there is no issue as to priority, and that opposers are the prior users. Opposers argue that applicant's marks, SYNERGY. WORKING TOGETHER WORKS. and SYNERGY REHABILITATION, INC. and design, are highly similar to their mark, SYNERGY PHYSICAL THERAPY, because SYNERGY is the first, and dominant, audio-literal term in each mark, and, thus, the term most likely to be remembered by purchasers. Opposers also argue that the connotations of the marks are the same. Opposers contend that there is no issue as to the relatedness of the services because the services are identical, at least with respect to "physical therapy services." Opposers argue further that the channels of trade for the services are the same, and that the services embrace all levels of buying and/or purchasing consumers; that patients come to opposers with and without prescriptions; that some patients seek opposers' services even though their prescriptions name a different physical therapy organization; that opposers chose the name to avoid reliance on individual therapist reputation; that physical therapy is for correcting dysfunction and is not massage or fitness training; and that action has been taken against a third party who caused actual confusion when such use was discovered. Opposers also

contend that any third-party uses of the term SYNERGY shown by applicant are outside the parameters of the services as set forth by applicant and opposers and are, therefore, not relevant to the issue of likelihood of confusion between the subject marks herein. Opposers argue that their mark is not weak, but distinctive, and the term SYNERGY is the equivalent of SYNERGY PHYSICAL THERAPY because PHYSICAL THERAPY is generic for the services rendered under the mark.

In response, and in its cross motion for summary judgment, applicant argues that there are no genuine issues of material fact, that confusion is not likely, and that it is entitled to judgment as a matter of law. In particular, applicant argues that confusion is not likely because the practical market realities include: a requirement for a medical prescription, patient referral, importance of personal relationships and reputation of the therapists, common practice in the field of selecting similar tradenames and trademarks, and increasing popularity of the term SYNERGY as part of a trademark within the trade. Applicant contends that the term SYNERGY is "hot," and in recent years has become extremely popular for business of all types, including the health industry. Applicant argues further that there are distinct differences between the parties' respective marks; that the term SYNERGY is weak and used extensively by third parties, including those in the health care field; and that there is an absence of any evidence of actual confusion. Applicant argues that the marks must be compared in

their entireties rather than focusing only on the term SYNERGY, and that there are other elements in each of its marks which distinguish them and create different commercial impressions from opposers' mark. Applicant acknowledges a certain amount of overlap in the parties' services but argues that, due to substantial third-party use of the term SYNERGY in the health care field, consumers are able to distinguish among the various service providers and products in the industry. Applicant concedes that the recitations of services in its applications and opposers' registration are unrestricted, but contends that other factors, including differences in the marks and third-party uses of the term SYNERGY, negate any impact of the services travelling in the same channels of trade. Applicant argues that a high degree of care is exercised by medical professionals and patients in connection with physical therapy services, thus reducing any possibility of confusion, and that there has been no actual confusion.

Opposers' motion for summary judgment is accompanied by the following: a status and title copy of opposer's pleaded Registration No. 1,915,713; a dictionary definition of the term "synergy;" a certified copy of opposers' application Serial No. 75/176,768, against which applicant's applications had been referenced; copies of communications from the office of the Assistant Commissioner for Trademarks concerning a petition filed by opposers; a declaration of opposers that they are the owners of the pleaded registration and above referenced application;

copies of applicant's specimens in its applications; copies of documents produced by applicant in response to opposers' discovery requests showing applicant's use of the term SYNERGY in advertising; a copy of applicant's answers and objections to opposers' first and second sets of admissions; a declaration of Paul A. Holmquist; a copy of the petition decision of the Assistant Commissioner for Trademarks concerning opposers' application Serial No. 75/176,768; and a copy of opposers' Registration No. 2,246,947 into which application Serial No. 75/176,768 matured.

Applicant's response and cross motion for summary judgment is accompanied by the following: copies of fifteen federal registrations consisting, at least in part, of the term SYNERGY; Internet Yellow Page listings of companies operating under the name SYNERGY, or variations thereof; the declaration of Laura A. Newman, attorney for applicant, in support of associated exhibits; a copy of a trademark search report for the term SYNERGY covering federal and state registrations and common law uses; copies from the Internet of information about various products and services apparently offered under the term SYNERGY; copies of pages thirteen-fourteen of opposers' response to applicant's first interrogatories; the declaration of Jane Wintersteen, president and general manager of Synergy Rehabilitation, Inc., and accompanying exhibits; the declaration of Anne Randolph, executive vice president of Client Services for Synergy Rehabilitation, Inc., and accompanying exhibits; the

declaration of Grace Medina-Chow, executive vice president of Business Operations for Synergy Rehabilitation, Inc., and accompanying exhibits; the declaration of Suellen Smith, administrative director of Doctors Medical Center-Pinole Campus, and accompanying exhibits; the declaration of Jim Kanyusik, legal assistant with the law firm representing applicant, and accompanying exhibits; the declaration of Anne Archambault, legal assistant with the law firm representing applicant, and accompanying exhibits; the declaration of Timothy Thor, physical therapist for Guardian Health Group; the declaration of Mary Oates, physical medicine and rehabilitation practitioner; and a second declaration of Jane Wintersteen, and accompanying exhibits.

Opposers' requests to file a new paper and newly acquired evidence

Opposers have requested leave to file a new paper for consideration of a petition decision rendered by the Assistant Commissioner for Trademarks granting opposers' petition, in part, to lift suspension of opposers' application Serial No. 75/176,768 for the mark SYNERGY for "physical therapy services" in Class 42 in order to allow the subject application to proceed to publication.[4] Opposers have characterized the petition decision

[4] Application Serial No. 75/176,768, claiming use in commerce since June 17, 1993 and first use anywhere since January 22, 1991, was filed subsequent to applicant's applications which are the subject matter of this proceeding. Applicant's pending applications were referenced by

as "the best evidence of what it contains." Opposers have also requested leave to file as newly acquired evidence a copy of Registration No. 2,246,947,[5] the registration into which application Serial No. 75/176,768 matured. Opposers further request leave to later file a certified copy of Registration No. 2,246,947, indicating that such a copy was not available when opposers filed their request for leave to file newly acquired evidence. Applicant has not filed any response to opposers' requests.

If a plaintiff's registration is pleaded, and such a pleading is accompanied by a status and title copy of the registration prepared by the Patent and Trademark Office, the registration is of record for all purposes, including summary judgment. Alternatively, a plaintiff may make its pleaded registration of record for the purposes of summary judgment by filing a status and title copy with its brief on the summary judgment motion. See Trademark Rule 2.122(d)(1); and TBMP Section 528.05(d).

Opposer has not filed a motion to amend the notice of opposition to plead the additional registration that opposer now seeks to make of record; and opposer was not able to include a status and title copy of Registration No. 2,246,947. Moreover,

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the Examining Attorney as potential bars to registration of opposers' later filed application.

[5] U.S. Registration No. 2,246,947, for the mark SYNERGY for "physical therapy services" in Class 42, registered on May 25, 1999 and claiming use in commerce since June 17, 1993, first use anywhere January 9, 1991.

the Board does not find it necessary to its decision herein that Registration No. 2,246,947 be made of record.[6]

Accordingly, opposer's requests for leave to file a new paper in the nature of a petition decision rendered by the Assistant Commissioner for Trademarks and for leave to file newly acquired evidence in the nature of a copy of Registration No. 2,246,947 are denied.

Opposers' objections to applicant's evidence

Opposers have objected to applicant's submissions of evidence and supporting declarations on the basis that applicant's evidence is irrelevant, constitutes hearsay, and amounts to an abusive and harassing presentation of a "hodgepodge."

For purposes of summary judgment, a party may make of record copies of other registrations; documents or things produced in response to a request for production; official records, if competent evidence and relevant to an issue; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue, if the publication is competent evidence and relevant to an issue; and testimony from other proceedings,

[6] The Board notes further that, in any event, even if this evidence had been considered on opposers' behalf, it would simply be cumulative to that already of record.

so far as relevant and material. In addition, affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (l) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. See Fed. R. Civ. P. 56(e). This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. Moreover, a copy of a trademark search report, made of record as an exhibit to an affidavit, submitted in opposition to a summary judgment motion, may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). See, also, TBMP Section 528.

Opposers' blanket objections to applicant's evidentiary submissions and declarations will not be upheld, and the Board has considered applicant's evidence in determining the motions for summary judgment before us. See, for example, *Jean Patou Inc. v. Theon Inc.,* 18 USPQ2d 1072 (TTAB 1990).

Applicant's objection to opposers' addition to the record

In accompaniment with their brief in response to applicant's cross motion for summary judgment, opposers included the declaration of Paul A. Holmquist as an addition to the record for

summary judgment. Applicant has objected to opposers' addition to the record for summary judgment. Specifically, applicant objects to Paragraph No. 9, wherein Mr. Holmquist states that Synergy Health Center in St. Paul, Minnesota "terminated its use of Synergy in October of this year," as impermissible hearsay and further requests that the statement be stricken. Applicant also objects to Paragraph No. 11 on the basis of relevancy, arguing that statements concerning the comparative need by hospitals and nursing homes for physical therapists versus occupational and speech therapists are not relevant to the issues at hand.

Hearsay, a statement other than one made by the declarant while testifying at trial or hearing offered into evidence to prove the truth of the matter asserted, is not admissible except as specifically provided. See Fed. R. Evi. 801, 802 and 803.

The statement made in Paragraph No. 9 of the declaration of Paul A. Holmquist does not fall into any of the hearsay exceptions and is hereby stricken.

As to the statement made in Paragraph 11 of the declaration of Paul A. Holmquist, applicant's objection is noted. See, for example, *Jean Patou Inc. v. Theon Inc.,* 18 USPQ2d 1072 (TTAB 1990).

Likelihood of confusion

The Board now turns to the parties' cross motions for summary judgment. In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine

issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

In determining the issue of likelihood of confusion, and hence whether there is any genuine issue of material fact relating thereto, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion, as identified in *In re E.I du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, each of the factors, from case to case, may play a dominant role. *Id.,* 476 F.2d at 1361, 177 USPQ at 567. Those factors as to which we have probative evidence are discussed below. After a careful review of the record in this case, we find that there are no genuine issues of material fact relating to those factors.

Preliminarily, insofar as priority is concerned, opposers' submission of a status and title copy of its pleaded registration for the mark SYNERGY PHYSICAL THERAPY, showing that this

registration is subsisting and owned by opposers, is sufficient to establish priority with respect to the services recited in the registration. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As to the services offered by each party, opposers' identified services, "physical therapy services," and applicant's identified services, "physical, occupational and speech therapy services," are identical in part as to "physical therapy services." In addition, applicant acknowledges "a certain degree of overlap" in the parties' respective services. Thus, the services are either the same or closely related.

As to the channels of trade, applicant concedes that the recitations of services in opposers' registration and applicant's applications are unrestricted. Thus, the Board must presume that the services travel in all the normal channels of trade available for the services. See *Kangol Ltd. v. KangaROOS U.S.A.,* 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992). Applicant attempts to negate the impact of the parties' respective services travelling in the same channels of trade by arguing that a higher degree of care is exercised by the medical professionals and patients in connection with physical therapy services and that market conditions, including physician referral and professional relationships, reduce any possibility of confusion between the parties' marks. However, where the services are the same and overlapping, and travel in the same channels of trade, even sophisticated and knowledgeable consumers are not infallible in

their recollection of trademarks. See, for example, *HRL Associates, Inc. v. Weiss Associates, Inc.,* 12 USPQ2d 1819 (TTAB 1989), aff'd on point, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

The key factor in this case is the degree of similarity of the marks being used by opposers and applicant: SYNERGY PHYSICAL THERAPY, opposers' mark; and SYNERGY. WORKING TOGETHER WORKS; and SYNERGY REHABILITATION, INC. and design, applicant's marks. In comparing the marks, the Board is guided by the general principle that the greater the degree of similarity of the products or services, the lesser the degree of similarity of the marks that is required for there to be a likelihood of confusion. See *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). It is equally well established that, although the marks must be considered in their entireties, there is nothing improper in giving more or less weight to a particular feature of a mark, particularly where portions of the marks are descriptive or generic. See *In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Dixie Restaurants, Inc.,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's marks, SYNERGY. WORKING TOGETHER WORKS; and SYNERGY REHABILITATION, INC. and design, and opposers' mark, SYNERGY PHYSICAL THERAPY, are similar in appearance, sound, connotation and commercial impression. SYNERGY is the dominant, audio-literal, source-indicating portion of each mark. The terms

PHYSICAL THERAPY in opposers' mark and REHABILITATION, INC. in one of applicant's marks do not serve to diminish the similarities of the marks because, being descriptive and/or generic, they identify the services. In applicant's mark SYNERGY REHABILITATION, INC. and design, SYNERGY is dominant because it is presented in large lettering over the design. Also, greater weight generally is given to a word portion of the mark, because it is by the words that purchasers will refer to the goods, and the words, rather than the design feature or the stylized lettering, will therefore make a greater impression on the consumers. See *Ceccato v. Maniffatura Lane Gaetano Marzotto y Figli S.p.A.,* 32 USPQ2d 1192 (TTAB 1994); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). In applicant's mark SYNERGY. WORKING TOGETHER WORKS., the second phrase serves to emphasize the meaning of the term SYNERGY, that is, "to work together; combined or cooperative action or force." (See opposers' Exhibit No. 2.) In addition, applicant emphasizes the term SYNERGY in its advertising and uses the term SYNERGY, centered, over the phrase WORKING TOGETHER WORKS. (See opposers' Exhibit Ltrs. A-E.) Comparison of the commercial impressions created by competing marks in their commercial context is appropriate. See *Giant Food, Inc. v. Nation's Foodservice, Inc.,* 710 F.2d 1569, 218 USPQ 393 (Fed. Cir. 1983). A comparison of the parties' respective marks shows that they are similar.

Applicant's evidence in support of its argument that the term SYNERGY is weak and extensively used by third parties,

thus enabling consumers to distinguish minor differences between the marks, is unpersuasive. The third-party uses which are relevant to this proceeding would involve uses in connection with "physical, occupational and speech therapy." The evidence submitted by applicant reveals only eight apparent uses of the term SYNERGY in connection with such services. The case of *Steve's Ice Cream v. Steve's Famous Hot Dogs,* 3 USPQ2d 1477 (TTAB 1987), upon which applicant relies, is distinguishable. In that case, the evidence of third-party use submitted by the applicant showed numerous uses of the term STEVE'S and its derivatives, STEPHEN and STEVEN, in connection with the services at issue in the case, including 173 restaurants and 87 food stores. See, also, *In re Broadway Chicken, Inc.,* 38 USPQ2d 1599 (TTAB 1996), where no likelihood of confusion was found between applicant's mark BROADWAY CHICKEN for "restaurant services" and opposer's marks BROADWAY PIZZA for "restaurant services" and BROADWAY PIZZA & BAR for "restaurant and bar services," and the evidence submitted included more that 575 directory listings of entities whose names contained the term BROADWAY and who offered restaurant services. We are not persuaded that the minimal number of apparent third-party uses herein raises a material issue of fact for trial. Stated differently, the Board is convinced that there is a likelihood of confusion here as a matter of law, where substantially similar marks are used in connection with the same services, even assuming the existence of these eight third-party uses.

Although there is no evidence of actual confusion between the parties' respective uses, this does not preclude a finding of likelihood of confusion. See, for example, *Walgreen Co. v. Knoll Pharmaceutical Co.,* 162 USPQ 609 (TTAB 1969).

Considering the substantial similarities between the marks, we find that, when used on the identical and/or closely related services, confusion is likely to result. Opposers, therefore, have met their burden of establishing that no genuine issues of material fact exist and that confusion is likely.

Accordingly applicant's cross motion for summary judgment is denied; opposers' motion for summary judgment is granted, judgment is entered against applicant and registration to applicant is refused.

Applicant's alternate motion to divide its applications

Applicant has filed an alternate motion to divide its applications in the event that applicant's cross motion for summary judgment is not favorably received. By its motion to divide, applicant seeks to separate "physical therapy services" from "occupational and speech therapy services," arguing that the latter two services have not been opposed.

In response, opposer argues that its motion for summary judgment does not constitute a withdrawal or waiver of any of the pleadings; that such a separation of the services would be an artificial separation because the services are combined as a

package; and that such a separation would not avoid likelihood of confusion.

A motion to divide is appropriate where an application which is the subject of an opposition includes more than one service in a single class, and the opposition is not directed to all of the services. See Trademark Rule 2.86(a); and TBMP Section 516.

The Board has carefully reviewed the complaint in this opposition and finds that opposer did not direct the opposition to only "physical therapy services," but to all services recited by applicant in its applications.

Accordingly, applicant's alternate motion to divide the applications is denied, and all services recited in each of the applications which are before the Board on this opposition are subject to this opposition proceeding, and the grant of summary judgment to opposers operates as judgment against applicant as to all the recited services in the applications.

T. J. Quinn

H. R. Wendel

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial and
Appeal Board